



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,170	04/09/2004	Akihiko Chiba	108-421-00096	8399
4372	7590	03/19/2008		
ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER ROE, JESSEE RANDALL	
			ART UNIT 1793	PAPER NUMBER
			NOTIFICATION DATE 03/19/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

Office Action Summary

Application No.

10/821,170

Applicant(s)

CHIBA ET AL.

Examiner

Jessee Roe

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 and 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-16 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

Claims 1-26 are pending wherein claims 1 and 15 are amended and claims 5-10 and 17-22 are withdrawn from consideration.

Status of Previous Rejections

The previous rejection of claims 1-4, 11-16 and 23-26 under 5 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the Applicant's amendments to the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 11-16 and 23-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to the recitation "the alloy being Ni-free" of claims 1 and 15, the Examiner notes that although in paragraph [0006] of the "Related Art" section of the

Art Unit: 1793

instant specification "there has been a strong demand for development of Ni-free fine wire with Mo content of 8 weight % or more", there is not a recitation of the alloy being "Ni-free" in the "SUMMARY OF THE INVENTION" section or the "EXAMPLES" section of the instant specification.

Claims 2-4, 11-14, 16 and 23-26 are rejected because of their dependence upon rejected base claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 11-16 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson (US 5,891,191).

Claims 1-4, 11-16 and 23-26 are rejected on the same grounds as set forth in the Office Action of 1 October 2007.

With respect to the amended feature of claims 1 and 15 which recites "for biomaterials", the alloy disclosed by Stinson ('191) would be biocompatible (col. 3, lines 32-45).

With respect to the amended feature of claims 1 and 15 which recites "the alloy being Ni-free", the alloy disclosed by Stinson ('191) would not necessitate the presence of nickel because the alloy disclosed by Stinson ('191) would contain "less than about 2

weight percent nickel", which would include 0 weight percent (col. 3, lines 32-45 and claim 2). MPEP 2144.05 I.

Claims 1-4, 11-16 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson (US 5,891,191) in view of JP 2002-363675 A .

Claims 1-4, 11-16 and 23-26 are rejected on the same grounds as set forth in the Office Action of 1 October 2007.

With respect to the amended feature of claims 1 and 15 which recites "for biomaterials", the alloy disclosed by Stinson ('191) would be biocompatible (col. 3, lines 32-45).

With respect to the amended feature of claims 1 and 15 which recites "the alloy being Ni-free", the Examiner asserts that neither the alloy disclosed by Stinson ('191) nor JP '675 would not necessitate the presence of nickel because the alloy disclosed by Stinson ('191) would contain "less than about 2 weight percent nickel" (col. 3, lines 32-45 and claim 2), which would include 0 weight percent and JP '675 discloses the optional presence of carbon with 0 to 0.3 weight percent carbon (abstract). MPEP 2144.05 I.

Response to Arguments

Applicant's arguments filed 2 January 2008 have been fully considered but they are not persuasive.

The Applicant primarily argues that the composition of the instant invention would be different than that of Stinson ('191) because the instant invention does not contain nickel and because of the claim language "consisting of". In response, the Examiner notes that Stinson ('191) would not require nickel because "less than about 2 weight percent nickel" would include 0 weight percent and would therefore not patentably distinguish from Stinson ('191). Further, JP '675 would not necessitate added elements beyond that of chromium, molybdenum and cobalt because JP '675 discloses 0 to 0.3 weight percent carbon (abstract). Therefore, the compositions of the prior art would be substantially identical to the composition of the instant invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessee Roe whose telephone number is (571) 272-5938. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JR

/John P. Sheehan/
Primary Examiner, Art Unit 1793

Application Number**Application/Control No.**

10/821,170

Examiner

Jessee Roe

**Applicant(s)/Patent under
Reexamination**

CHIBA ET AL.

Art Unit

1793